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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,258	10/06/2003	Takashi Kikuchihara	1419.1045C	3452
21171	7590	10/05/2005	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			COMAS, YAHVEH	
			ART UNIT	PAPER NUMBER
			2834	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/678,258

Applicant(s)

KIKUCHIHARA ET AL.

Examiner

Yahveh Comas

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-15 and 32-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/734703.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/25/2005.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Response to Arguments

The amendment filed on 6/27/2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: A motor for propelling a toy vehicle. Also the Examiner cannot readily ascertain/map with the above claim language where in the specification as originally filed a disclosure/support is found in the descriptive portion of the specification by reference to the drawings, designating the part or parts therein to which the terms "a motor for propelling a toy vehicle" applies. A disclosure in an application, to be complete, must contain such description and details as to enable any person skilled in the art to which the invention pertains to make and use the invention as of its filing date. In re Glass, 492 F.2d 1228, 181 USPQ 31(CCPA 1974)

Applicant is required to cancel the new matter in the reply to this Office Action.

Applicant's arguments with respect to claims 5-15 and 32-61 have been considered but are moot in view of the new ground of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 5-15 and 32-57 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject

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matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The specification or drawings, as originally filled, does not contain any written description of a motor for propelling a toy vehicle, therefore is a new matter.

Claims 5-15 and 32-57 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specifications do not provide a written description of a the motor propelling a toy vehicle or how the motor propels a toy vehicle (for example by using a gear assembly, the motor shaft directly connected to the wheels, etc.)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 5 – 15 and 32-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maxim U.S. Patent No. 4,476,648 in view of Sato et al. JP. Patent No. 10-084650.

Maxim discloses a toy vehicle with a DC motor unit connected to a battery by at least one connector. Maxim discloses the claimed invention except for a rotor or a motor unit having a first and a second terminal, a cylindrical case for covering and securing the motor unit or rotor, including a longitudinal axis, and a large case having a cylindrical conductive portion electrically connected between the second electrode terminal, and an insulating small case body directly provided with the first electrode terminal, the electrode terminal extends through the insulating small case body in a direction approximately parallel to the axis of the cylindrical case, laterally contacts the small case body and includes a first end which is electrically connected to the motor or rotor, and a second end which is exposed on an exterior end portion of the insulating small case body.

However, Sato discloses a rotor or a motor unit having a first and a second terminal, a cylindrical case (6) for covering and securing the motor unit or rotor, including a longitudinal axis, and a large case having a cylindrical conductive portion (6) electrically connected between the second electrode terminal (5-1), and an insulating small case body (7) directly provided with the first electrode terminal (5-2), the electrode

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terminal extends through the insulating small case body (7) in a direction approximately parallel to the axis of the cylindrical case, laterally contacts the small case body and includes a first end which is electrically connected to the motor or rotor, and a second end which is exposed on an exterior end portion of the insulating small case body. Also discloses at least one conductive member electrically connected to the cylindrical conductive portion (5-1) having a U shape which is between an exterior peripheral portion of the small case body (7) and an interior of the cylindrical conductive portion (6), but fail to show the terminals connected to the external battery directly or through at least one conductive member.

Therefore, it would have been obvious to one having skill in the art at the time the invention was made to modify Maxim's invention and provide a motor connected to a battery in order to provide a power to said motor.

Regarding claims 44 and 45 it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a battery parallel or perpendicular to the axis of the cylindrical case, since it has been held that rearranging position of a battery involves only routine skill.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yahveh Comas whose telephone number is (571) 272-2020. The examiner can normally be reached on 8am-5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darren Schuberg can be reached on 571-272-2044. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YC


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